



Docket No.: 208954US2RD CONT



ATTORNEYS AT LAW

ECKHARD H. KUESTERS
(703) 413-3000
EKUESTERS@OBLON.COM

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/973,235

Applicants: Hideaki FUKUZAWA, et al.

Filing Date: October 10, 2001

For: MAGNETORESISTANCE EFFECT ELEMENT,
MAGNETIC HEAD, MAGNETIC HEAD
ASSEMBLY, MAGNETIC STORAGE SYSTEM

Group Art Unit: 1773

Examiner: BERNATZ, K.

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Eckhard H. Kuesters

Registration No. 28,870

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

DOCKET NO: 208954US2SRD



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIDEAKI FUUZAWA ET AL : EXAMINER: BERNATZ, K.
SERIAL NO: 09/973,235 :
FILED: OCTOBER 10, 2001 : GROUP ART UNIT: 1773
FOR: MAGNETORESISTANCE EFFECT :
ELEMENT, MAGNETIC HEAD,
MAGNETIC HEAD ASSEMBLY,
MAGNETIC STORAGE SYSTEM

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the election requirement dated June 28, 2004, Applicants provisionally elect with traverse Species 3 = MR effect element comprising a synthetic second ferromagnetic layer as described above and a high-conductive material layer, an upper shield and a lower shield, for further examination on the merits. Applicants identify Claims 31-33 and 41-43 as readable on the elected species. Applicants reserve the right to file one or more divisional applications directed to the non-elected species.

Furthermore, while the Election Requirement asserts that the application contains claims to patentably distinct species, MPEP § 803 states the following:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

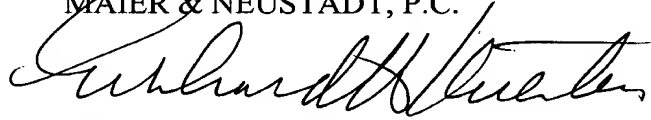
Application No. 09/973,235
Reply to Office Action of June 28, 2004

Although the outstanding Official Action does not identify search classifications, it is believed that the claims of the present application would have to be searched in a handful of sub-classes. Furthermore, since electronic searching is commonly performed, a search may be made of a large number of, or theoretically all, subclasses without substantial additional effort. Accordingly, Applicants respectfully traverse the Election Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would be a serious burden on Applicants to prosecute and maintain separate applications.

Therefore, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of Claims 29-42 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)

I:\ATTY\EHK\AMEND-RESPONSES\0039\20s\208954US-PE.DOC